

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. DISPOSITION OF THE CLAIMS

Claims 1-12 are pending in the subject application.

Claims 1, 3, 5, 7-8, and 10-12 are currently being amended. No new matter has been added.

Upon entry of this amendment, claims 1-12 will be pending and under examination.

II. INFORMATION DISCLOSURE STATEMENT

Applicants Representative thanks the Examiner for acknowledging, during a telephone conference on November 4, 2009, that Document A3 (US 5,450,352), submitted in the Information Disclosure Statement filed on June 4, 2007, should have been considered. Document A3 (US 5,450,352) is lined through in the Form PTO/SB/08 returned with the Office Action dated August 5, 2009.

Applicant respectfully requests that the Office indicate consideration of Document A3 (US 5,450,352) by returning an appropriately initialed copy of Form SB/08 to the Applicant.

To the extent a statement under 37 C.F.R. § 1.133(b) may be required in view of the telephone conference on November 4, 2009, the above comments satisfy such requirement.

III. INDEFINITENESS

Applicant has obviated this ground of rejection by amendment.

IV. NON-OBVIOUSNESS

The claims stand rejected over US 5,249,080 (Watson) and US 6,219,185 (Hyde). Applicant respectfully traverses.

A. Claims 1, 3, 5, And 7-8 Are Non-Obvious

Contrary to the Office's assertion, Watson fails to disclose an autonomous device. Instead, Watson discloses a new coronagraph comprising an apodizer that is part of a telescope, as it is clearly shown in figure 48. Watson states that "fig. 48 shows an example embodiment of an alignment system according to the present invention" (see column 10, lines 16-17) and "the stellar wavefront can be made to reflect at the required angle by using a holographic optical element (HOE). Apodizer 98 functions as the on-axis stellar stop of the coronagraph" (see column 10, lines 33-37). As clearly shown by figure 48, the coronagraph of Watson is in the telescope. The coronagraph of Watson is never described as an autonomous device, as recited in the claim 1.

Further, a person of ordinary skill in the art would not have been led to combine the teaching of Watson to the teaching of Hyde. In Hyde, on the contrary, the lens 10 is very far from the eyepiece (see Hyde, column 4, lines 7-8: "the separation between objective lens vehicle 10 and eyepiece vehicle 12 is so large (up to several kilometers) ...").

Therefore, a person of ordinary skill in the art would not consult Hyde, which is in a different field of technology from Watson and therefore nonanalogous art. Also, a person of ordinary skill in the art would not combine the teaching of Watson (in which there is a coronagraph in the telescope) with the teaching of Hyde (a telescope with a very far lens).

A skilled artisan would not have been led to consult Hyde all the more that Hyde relates to a goal that is exactly the opposite of that of Watson. The aim of Watson is to block a part of the light (see Watson, column 11, lines 6-12 for example), whereas the aim of Hyde is on the contrary to let the light pass (see Hyde, column 3, line 67, to column 4, line 2 for example).

And even if a skilled artisan combined the teaching of Hyde with the teaching of Watson, this would not yield the present invention as claims. Specifically, all limitations of the present claims would not be met. Hyde does not disclose that the lens 10 comprises a control means for controlling a propulsion means for moving or stopping the device, as stated by the examiner in the office action. On the contrary, Hyde explicitly discloses that it is the

“eyepiece vehicle 12,” and not the lens 10, that “is controllable to be maintained in alignment to the objective lens vehicle by conventional thrusters.” Hyde, column 4, lines 2-6.

Hyde does not disclose an autonomous device for blocking the light (the lens 10 lets the light pass) with a control means for controlling a propulsion means for moving or stopping the device (instead, the telescope 12 comprises the propulsion means). Claim 1 explicitly recites on the contrary that the autonomous device of the invention comprises a control means for controlling a propulsion means for moving or stopping the device.

Therefore, Watson and Hyde would not have led a person of ordinary skill in the art to the present invention as claimed. Applicants therefore request withdrawal of this ground of rejection for claim 1-9.

B. Claims 10-12 Are Non-Obvious

Regarding method claims 10-12, Applicant respectfully submits that the rejection is legally flawed. The Office asserted that combining Watson and Hyde would yield a device that “would inherently be capable of carrying out the method of claims 10-12”, and that the “motivation for doing so would have been to use the apparatus in a manner conducive to its design”. Office Action, page 4, lines 4-6 from bottom, and page 5, lines 11-12.

These comments indicate that in rejecting method claims 10-12, the Office relied on motivation based on a feature that is allegedly inherent and therefore unknown. Such reasoning is improper: Obviousness cannot be based on the unknown. *In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) (“That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.”).

Accordingly, the Office should withdraw this ground of rejection of claim 10-12.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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